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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,061

06/24/2003

Uma M. Krishnamurthy

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EXAMINER

LOFTIS, JOHNNA RONEE

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

12/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/603,061

**Applicant(s)**

KRISHNAMURTHY ET AL.

**Examiner**

Johnna R. Loftis

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a first office action upon examination of application number 10/603,061.

Claims 1-15 are pending and have been examined on the merits discussed below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how migration percentages are determined based on averaged assessment factor ratings. Is there some mathematical step missing? Is there a reference chart? What guidelines does one follow to arrive at migration percentages after assigning ratings to the assessment factors?

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-8, 10-13 and 15 rejected under 35 U.S.C. 102(a and e) as being anticipated by Macken, JR. et al, US 2003/0055697.

As per claim 1, Macken teaches collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); averaging the ratings to determine an average rating (para. 0039 – overall score is computed); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values are determined with respect to the process migration template).

As per claim 2, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 3, Macken teaches applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., “0” corresponds to a difficult migration).

As per claim 4, Macken teaches determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 5, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

As per claim 6, Macken teaches a data processing system (para. 0024) with means for collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); averaging the ratings to determine an average rating (para. 0039 – overall score is computed); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values are determined with respect to the process migration template).

As per claim 7, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 8, Macken teaches a data processing system (para. 0024) with means for applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., “0” corresponds to a difficult migration).

As per claim 9, Macken teaches a data processing system (para. 0024) with means for determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 10, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

As per claim 11, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); averaging the ratings to determine an average rating (para. 0039 – overall score is computed); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values are determined with respect to the process migration template).

As per claim 12, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 13, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., “0” corresponds to a difficult migration).

As per claim 4, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for determining employee migration figures by multiplying the employee percentages by the number of full time equivalent

employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 15, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zarb, US 2004/0039619 – methods and apparatus for facilitating analysis of an organization

Statfeld, US 2003/0055706 – system and method for determining staffing needs for functions in an office

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

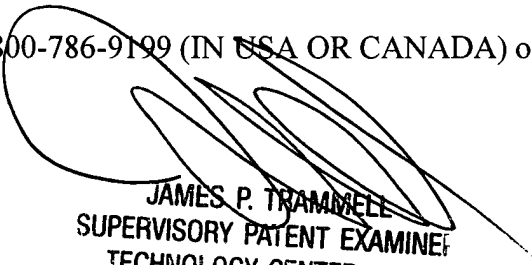
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/jl/  
12/18/07



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